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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/859,692	05/17/2001	W. W. Rhodes	10961133-6	1385

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EXAMINER

YOCKEY, DAVID F

ART UNIT	PAPER NUMBER
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2861

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DATE MAILED: 12/04/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/859,692

Applicant(s)

RHODES ET AL.

Examiner

David Yockey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-51 is/are pending in the application.
- 4a) Of the above claim(s) 32-38 and 46-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-31, 39-45 and 51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☒ The proposed drawing correction filed on 17 May 2001 is: a) ☐ approved b) ☒ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Preliminary Amendment

The preliminary amendment is improper, as claims 27-51 should be underlined in their entirety. Matter to be added in a reissue must be underlined. See 37 CFR 1.173(b)(2) and 1.173(d).

Election/Restrictions

Newly submitted claims 32-38 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

The inventions of the patent claims and of claims 32-38 are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the combination does not require a cartridge comprising a container of ink, an areas having orifice, a reservoir of printhead servicing fluid, and an applicator. The subcombination has separate utility such as applying servicing fluid to a cap which contacts the printhead during capping.

Because these inventions are distinct for the reasons given above and because additional search at least in Class 347, Subclass 87 required for Claims 32-38 is not required for the patent claims, restriction for examination purposes as indicated is proper.

The inventions of the patent claims and of claims 46-50 are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the process can be practiced with a different applicator, such as a single porous block of material having no tip, and with a different wiper, such as an ordinary rubber wiper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 32-38 and 46-50 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

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Oath/Declaration

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following:

A reissue oath/declaration from the inventor(s) has not been provided. A reissue oath/declaration from the inventor(s) is required since this is a broadening reissue application. See 37 CFR 1.172.

Drawings

The proposed drawing correction and/or the proposed substitute sheets of drawings, filed on 17 May 2001 have been disapproved because new Fig. 7B was not been labeled "New" and because Figs. 7 and 14 have not been labeled "Amended." See 37 CFR 1.173(b)(3).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 24, 39-45 and 51 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 24:

Recitations of "said movable container" lack antecedent basis.

Claims 39-45:

The claims do not define the structural relationship between the ink jet printing mechanism and the servicing system.

Claim 51:

"said biasing member" lacks antecedent basis.

Claim Rejections - 35 U.S.C. 251

Claims 1-5, 7-26 and 51 are rejected as being based upon a defective reissue oath/declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the oath/declaration is set forth in the discussion above in this Office action.

Claims 1-5, 7-15, 24, 27-31, 39, 43 and 51 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error

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within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claims 1-5, 7-15, 24, 39, 43 and 51:

Deletion of "movable" in recitation of the "container" provides the broadening aspect to the claims. At page 14, lines 3-4 of the amendment received 17 February 1998 (Paper #4) in the parent application, Applicants state "New claims 21-29 relate to the embodiment exemplified in Figs. 2-4 which uses a movable (vertically) container...", clearly indicating the provision of the cartridge as "movable" as a feature upon which patentability was predicated so as to avoid rejection in view of the prior art. Note that patent claims 1 and 24 correspond to claims 22 and 21 prior to renumbering in the parent application. Accordingly, Applicants have surrendered subject matter including system having a container which is not clearly recited as being movable.

Claims 27-31:

Presentation of the service station with neither an applicator nor a specific wiper provides the broadening aspect to the claims. At page 13, lines 3-4 of the amendment received 17 February 1998 (Paper #4) in the parent application, Applicants state with regard to claim 1 "Unlike Burke discussed in greater detail below which uses the wiper to apply the cleaning fluid to the printhead, applicant uses a separate applicator...", clearly indicating that presence of the applicator in the combination claimed was provided to distinguish over the prior art. Further, at page 13, lines 15-17 of the same amendment, Applicants state with regard to claim 14 "Burke does not show an

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arrangement with porous elastomeric foam situated between first and second impervious elastomeric layers of his wiper element", clearly indicating that the structure of the wiper in claim 14 was considered to distinguish from the prior art. Accordingly, Applicants have surrendered subject matter including a service station without at least one of an applicator and a wiper having a specific structure.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Yockey whose telephone number is (703) 308-3084. The examiner can normally be reached on weekdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, N. Le can be reached on (703) 308-0750. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3431 for regular communications and (703) 305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.


DAVID F. YOCKEY
PRIMARY EXAMINER

DY
November 29, 2001